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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,772	12/24/2004	Ernst Fuchs		6953

60333 7590 12/10/2008  
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EXAMINER
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SWIGER III, JAMES L

ART UNIT	PAPER NUMBER
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3775

MAIL DATE	DELIVERY MODE
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12/10/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,772	<b>Applicant(s)</b> FUCHS, ERNST	
	<b>Examiner</b> JAMES L. SWIGER III	<b>Art Unit</b> 3775	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-31 is/are allowed.
- 6) ☒ Claim(s) 12-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **handle** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

**It is also noted that the drawings have dark shadings and certain features are unclear. New, corrected drawings should be submitted.**

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 14-15, 18, 20-21 and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Daily (US Patent Number 5,358,507).

Daily discloses a surgical instrument/kit comprising a plurality of drilling elements, e.g. 10 (see figure 1) having a truncated cone (16) with respect to a drilling instrument with an outer surface line that is smooth and encloses an angle of no more than several degrees with an axis of the truncated cone and a handle (14) at an angle to the axis of the truncated cone and forms a comparatively sharp cutting edge with a circumferential surface of the truncated cone, wherein the truncated cone terminates in a region of its top surface by an additional surface that is rotationally symmetrical relative to the axis of the truncated cone and convex, wherein the angle of the handle to the axis of the truncated cone  $90^\circ$  and further comprising means for adjusting the angle of the handle relative to the axis of the truncated cone, e.g. manual adjustment or selection of the tool, and wherein each the surgical instrument of the plurality of surgical instruments has a fixed and a predetermined angle between the angle of the handle relative to the axis of the truncated cone, with each of the fixed and predetermined angle being graded as a sequence within the plurality of predetermined surgical instruments (see figure 1 and column 3, lines 3-4). It is also noted that the instruments would have a series of

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graded diameters, as their cross sections at least show an increase of diameter as they are measured up the cone length.

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Daily, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 12-15, 18, 20-21, 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Carr (US Patent Number 5,733,119).

Carr discloses various embodiments of a surgical instrument/kit comprising a plurality of drilling elements, e.g. 87 or 115 (see figures 8-10) having a first truncated cone (at approx 117) with an outer surface line that is smooth and encloses an angle of several degrees with an axis of the truncated cone and a handle (22), at an angle to the axis of the truncated cone, wherein the drilling element further comprises an additional truncated cone (84/112) coaxially contiguous with the truncated cone, the additional truncated cone having a top surface that faces a base surface of the truncated cone with the top surface of the additional truncated cone having a larger diameter than a

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diameter of the base surface of the truncated cone. The truncated cone terminates in a region of its top surface by an additional surface that is rotationally symmetrical relative to the axis of the truncated cone and is concave and forms a comparatively sharp cutting edge with a circumferential surface of the truncated cone and the truncated cone terminates in a region of its top surface by an additional surface that is rotationally symmetrical relative to the axis of the truncated cone and convex. The angle of the handle relative to the axis of the truncated cone is approximately  $90^\circ$  (as shown in Fig. 6) and further comprises a means for adjusting the angle of the handle relative to the axis of the truncated cone, e.g. vibration, wherein the handle is detachably fixed to the drilling element, (see column 1, lines 56-60) wherein each the surgical instrument of the plurality of surgical instruments has a fixed and a predetermined angle between the angle of the handle relative to the axis of the truncated cone, with each of the fixed and predetermined angle being graded as a sequence within the plurality of predetermined surgical instruments (see various embodiments disclosed in figures 1-10). It is also noted that the instruments would have a series of graded diameters, as their cross sections at least show an increase of diameter as they are measured up the cone length.

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Carr, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the

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subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daily (US Patent Number 5,358,507) in view of Jorneus et al. (US Patent Number 5,741,267).

Daily discloses the claimed invention except for the markings on the cone. Jorneus et al. disclose a drilling device and teach the use of markings for depth indications to prevent damage to nerves and nerve systems in the jaw (see column 1, lines 24-26 and column 2, lines 50-52). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Daily with markings on the cone, in view of Jorneus et al., as depth indications to prevent damage to nerves and nerve systems in the jaw.

Claims 16-17, 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daily (US Patent Number 5,358,507). Daily discloses the claimed

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invention except for the cone/handle angle being a certain value, such as 70, 80 or 100 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the series of angles having degrees of 70, 80 or 100, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carr (US Patent Number 5,733,119) in view of Jorneus et al. (US Patent Number 5,741,267).

Carr discloses the claimed invention except for the markings on the cone. Jorneus et al. disclose a drilling device and teach the use of markings for depth indications to prevent damage to nerves and nerve systems in the jaw (see column 1, lines 24-26 and column 2, lines 50-52). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Carr with markings on the cone, in view of Jorneus et al., as depth indications to prevent damage to nerves and nerve systems in the jaw.

Claims 16-17, 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr (US Patent Number 5,733,119). Carr discloses the claimed invention except for the cone/handle angle being a certain value, such as 70, 80 or 100 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the series of angles having degrees of 70, 80 or 100, since it has been held that where the general conditions of a claim are disclosed in

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the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

***Allowable Subject Matter***

Claims 27-31 are allowed.

Applicant's arguments with respect to claims 12-26, have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER III whose telephone number is

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(571)272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L SWIGER/  
Examiner, Art Unit 3775  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733